

Appln. No. 10/706,425
Filing Date: November 12, 2003
Response filed October 2, 2007
Reply to Office action mailed May 2, 2007

REMARKS

Claims 22-55 are pending in the Application, and all were rejected in the Office action mailed May 2, 2007. Claims 22, 37, and 49 are amended by this response. Claims 22, 37, and 49 are independent claims. Claims 23-36, 38-48, and 50-55 depend, respectively, from claims 22, 37, and 49.

Claim Rejections

Rejections Under 35 U.S.C. §103(a)

Claims 22-55 were rejected under 35 U.S.C. §103(a) as being unpatentable over Meyerson et al. (US 5,579,487, hereinafter "Meyerson") in view of Morris et al. (US 4,884,132, hereinafter "Morris"). Applicants respectfully traverse the rejection. Nevertheless, Applicants have amended claims 22, 37, and 49 to more clearly define the subject matter of the claims.

The Applicant respectfully submits that the Examiner has failed to establish a case of prima facie obviousness for at least the reasons provided below. M.P.E.P. §2142 clearly states that "[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." The M.P.E.P. §2142 goes on to state that "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

With regards to the rejections of amended claims 22, 37, and 49, Applicants respectfully submit that the proposed combination of references fails to teach, suggest, or disclose, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in amended claims 22, 37, and 49. Applicants respectfully submit that the Meyerson and Morris references, taken alone or in combination, do not teach or suggest anything with respect to the automatic selection of a wireless communication path based upon a type of data being communicated, in accordance with Applicants amended claims 22, 37, and 49.

Applicants respectfully submit that instead, Meyerson discloses "... improved kinds of portable work slate units which are configurable by selection of a changeable complement of removable modules from a wide variety of types. The work slate units provide operation on a highly integrated basis with operational capabilities determined by the particular selection of removable modules, whose inclusion and interchangeability are facilitated by a standardized docking interface and intelligent bus arrangement." (Abstract) Applicants appreciate recognition in the Office action that Meyerson "...does not expressly disclose using the wireless communication interface for transmitting an image." (Office action at page 2) Applicants respectfully submit that Meyerson also does not disclose using the wireless interface for the transmission of speech data. Accordingly, Meyerson cannot therefore teach or suggest "...wherein a path used by the device to wirelessly communicate data is automatically selected based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in amended claims 22, 37, and 49.

Applicants respectfully submit that instead, Morris discloses that "...[a] personal security system transmits a picture of an object, such as a criminal suspect, and the

identification of a portable transmitter, such as the social security number of the user, to a receiver at a remote location. Time of transmission is recorded. If a crime occurs, the time, picture of the suspect, and identification of the victim are obtained from a recorder at the receiver. A potential victim of a crime points his portable personal security unit at a criminal suspect and presses an activating switch. The unit senses available light on the object and provides a flash if required. At the same time focusing an aperture control is performed and an image of the object is admitted to an image recorder which is a focal plane sensor array. Image data from the focal plane sensor array is processed in an image data processor and the processed image data is fed to a cellular communication transmitter for transmitting to the remote receiving station. An audio pickup at the portable unit is connected to the receiver for transmitting voice communications over the transmitter. By pointing the device at a suspect and pressing a button, a person makes a permanent record of an image.” (Abstract) Applicants respectfully submit that, like Meyerson, Morris also fails to say anything respect to selection of a communication path, let alone “...wherein a path used by the device to wirelessly communicate data is automatically selected based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited in amended claims 22, 37, and 49.

With respect to the teachings of Meyerson, the Office action asserts that “...all CCDs consist of integrated circuitry for processing captured image...” (Office action at page 2) Applicants respectfully disagree with this clearly conclusory statement. According to MPEP §2112, Sec. IV, page 2100-54,55, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (emphasis added)

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Applicants respectfully submit that the Office has failed to present a basis for such a statement. Applicants respectfully submit that CCDs (charge coupled devices) comprise circuitry to process signals, and may, but do not necessarily comprise integrated circuitry to process an image. For example, some charge coupled devices are used in charge coupled memory, and some in the processing of audio signals, both of which are different from and do not teach an image. Even those that do sense light do not necessarily comprise integrated circuitry to process an image. (See, e.g., Academic Press Dictionary of Science and Technology, Academic Press, Inc., 1992, page 405, copy attached) Therefore, Applicants respectfully submit that the Office has failed to present any grounds supporting the statement that "...all CCDs consist of integrated circuitry for processing captured image...", as asserted in the Office action, and which is clearly not true.

With respect to dependent claims 25-27 and 41-42, the Office asserts Meyerson discloses "...that the image is text, handwriting or a picture (inherent since all charge coupled devices can capture [an] image, and text, handwriting or pictures are all images, and the process in which the image is being processed by the CCD is when information in the image [is] being identified...." Applicants respectfully disagree with this conclusory statement regarding the allegedly inherent teachings of Meyerson, and respectfully submit that the Office has failed to set forth a proper basis showing where the proposed combination of Meyerson and Morris teaches or suggests the limitations of Applicants' claims 25-27 and 41-42.

Applicants again respectfully submit that MPEP §2112, Sec. IV, page 2100-54,55, makes it quite clear that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary

skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

Applicants respectfully submit that the term “image” may be defined as “...the optical counterpart of an object produced by an optical device (as a lens or mirror) or an electronic device....” (See, e.g., Merriam-Webster’s Collegiate Dictionary – Tenth Edition, Merriam-Webster, Inc., 2002, page 577, copy attached) Applicants also respectfully submit that charge coupled device (CCD) line scan image sensors (which are, by definition, CCDs), in and of themselves do not inherently capture an image, but rather, produce a signal containing information about the intensity of light sensed along a straight line, which is different from an image such as, “...text, handwriting, or pictures....”

In addition, Applicants respectfully disagree with the assertion that “Meyerson discloses ... the process in which the image is being processed by the CCD is when information in the image [is] being identified.” (Office action at page 3) Applicants respectfully submit that Meyerson merely mentions “...a handwriting recognition module...,” neither Meyerson nor Morris teach or suggest anything with respect to identification of information in an image. Applicants respectfully submit that handwriting recognition is different from and does not teach, suggest, or disclose the identification of information in an image. Applicants respectfully submit handwriting recognition normally assumes that handwriting is present and being analyzed, in order to identify what handwritten symbols are present. Applicants therefore respectfully submit that the Office has failed to forth a proper basis showing where the proposed combination of Meyerson and Morris teaches or suggests the limitations of Applicants’ claims 25-27 and 41-42.

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With regard to claims 28 and 47, the Office takes Official Notice that "...the use of speech communication in cellular network is well known in the art." (Office action at page 3) With regard to claims 31-33 and 45, the Office takes Official Notice that "...local area network, packet network, and TCP/IP network are all well known in the art." (Office action at page 4)

Applicants respectfully challenge the conclusory assertions made in the Office action without any supporting evidence that the elements recited in claims 28, 31-33, 45, and 47 are well known or obvious in the art. Applicants respectfully submit that the elements recited in claims 28, 31-33, 45, and 47 were not well known or obvious in their respective contexts, at the time the invention was made. Applicants respectfully submit that, for example, in the context of the elements as recited in independent claim 22 and independent claim 37, the elements in dependent claims 28 and 31-33, and claims 45 and 47 were not well known or obvious, at the time the invention was made.

M.P.E.P. §2144.03(E) states that "[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based." Accordingly, in order to maintain the rejections, Applicant respectfully requests that the Examiner produce references in support of the Examiner's contentions or, if the Examiner is relying upon personal knowledge to support the findings of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the findings. (See, e.g., M.P.E.P. §2144.03 and 37 C.F.R. §1.104(d)(2).)

With regard to claims 34, 35, 43, 44, 53 and 54, the Office asserts Meyerson discloses "...that decoding the image from a first representation to a second representation; and the second representation is a digital representation (inherent since

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a CCD senses an image of an object, which is the first representation, and turns the captured image into a digital format, which is the second representations of the image)." (Office action at page 5) Applicants respectfully disagree with this conclusory statement regarding the allegedly inherent teachings of Meyerson, and respectfully submit that that the Office has failed to show where the proposed combination of Meyerson and Morris teaches or suggests the limitations of Applicants' claims 34, 35, 43, 44, 53 and 54.

Applicants again respectfully submit that MPEP §2112, Sec. IV, page 2100-54,55, makes it quite clear that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"

Applicants disagree with the assertion that it is inherent that a CCD "...turns the captured image into a digital format...", as set forth in the Office action. While it may be true that some CCDs produce a digital output, it is not true that all CCDs necessarily produce a digital output. For an example of one CCD that produces an analog output, the Examiner is respectfully requested to review the data sheet for the Fairchild CCD 111 Line Scan Image Sensor, retrieved on October 2, 2007 from "<http://www.fairchildimaging.com/proddetail.asp?prod=CCD111ADC>" (copy attached).

Based at least upon the above, Applicants respectfully submit that the proposed combination of Meyerson and Morris fails to teach or suggest all of the limitations of Applicants amended claims 22, 37, and 49, and therefore, their respective dependent

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claims, as required by M.P.E.P. §2142, and that a rejection of claims 22, 37, and 49 and their respective dependent claims under 35 U.S.C. §103(a), cannot be maintained.

Therefore, Applicants believe that amended claims 22, 37, and 49 are allowable, for at least the reasons set forth above. Applicants respectfully submit that claims 23-36, 38-48, and 50-55 depend, respectively, from allowable claims 22, 37, and 49. Because claims 23-36, 38-48, and 50-55 depend from claims 22, 37, and 49, Applicants respectfully submit that claims 23-36, 38-48, and 50-55 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejection of claims 22-55 under 35 U.S.C. §103(a) be withdrawn.

Conclusion

In general, the Office Action makes various statements regarding claims 22-55 and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim). An early Office Action on the merits and allowance of claims 22-55 is respectfully requested.

Applicants respectfully submit that the claims of the present application should be in condition for allowance for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or Applicants can be of any assistance, the Examiner is invited to contact Applicants.

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The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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